

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Venkatesh P.
Gopinath, et al.

)
) Group Art Unit: 2812
)
) Examiner: Stanetta D. Isaac

Serial No.: 09/991,202

)
) Atty. Docket No.: 01-555

Filed: November 21, 2001

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For: Shallow Trench Isolation Structure
With Low Trench Parasitic Capacitance

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RESPONSE TO OFFICIAL ACTION
Restriction/Election Requirement

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed August 25, 2004, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group I, method claims 1-26.

Remarks/Arguments

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

In searching the Group I claims, the class and subclass for the Group II claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent

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Re: 09/991,202

Number of Pages Including this Page 4

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MESSAGE:

**US Serial No.: 09/991,202
Filing Date: November 21, 2001
Group Art Unit: 2812
Docket No: 01-555
Examiner: Stanetta D. Isaac
Response to Restriction Requirement**

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PTO/SB/21 (02-04)

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Application Number	09/891,202
Filing Date	November 21, 2001
First Named Inventor	Venkatesh P. Gopinath, et al.
Art Unit	2812
Examiner Name	Stanetta D. Isaac
Attorney Docket Number	01-555

Total Number of Pages in This Submission

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Remarks

Response to Restriction Requirement

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Timothy R. Croll 36,771 (408) 433-7625
Signature	
Date	September 14, 2004

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Typed or printed name
Manu Kashyap

Signature

Date 09/14/2004

This collection of information is required by 37 CFR 1.5. This information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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